

REMARKS

This Application has been reviewed carefully in light of the Office Action mailed October 3, 2003. Claims 1-30 were pending in the Application. Claims 1-12 stand withdrawn from consideration; Claim 15 stands objected to; and Claims 13-30 stand rejected. Applicant amends Claims 15 and 22 to correct typographical errors. Applicant adds new Claims 31-38, which are fully supported by the specification as originally filed.

Information Disclosure Statement

The Examiner has not notified Applicant that the Information Disclosure Statement filed by Applicant on September 12, 2003 has been considered. Applicant respectfully requests the Examiner to consider this Information Disclosure Statement and notify Applicant of such consideration.

Interview Summary

Applicant's attorney, Mr. Terry J. Stalford (Reg. No. 39,522), conducted a telephonic interview with Examiner Thomas J. Mauro, Jr. on September 12, 2003. Applicant submits this summary of the telephonic interview to record Applicant's understanding of the substance of the interview and to comply with M.P.E.P. § 713.04.

During the interview, the Examiner and the attorney for Applicant discussed the Examiner's election restriction. In response to the election restriction, Applicant provisionally elected, without traverse, to prosecute Claims 13-30 in this Application. In response, the Examiner withdrew Claims 1-12 from this Application as being drawn to a non-elected invention.

Applicant thanks the Examiner for the courtesy and opportunity to conduct the telephonic interview.

Election Restriction

As requested by the Examiner, Applicant affirms the election to prosecute Claims 13-30 in this Application. Applicant reserves the right to prosecute Claims 1-12 in continuation or other applications.

Statement Concerning Common Ownership of Patent Application No. 09/452,751

Applicant provides the Examiner this statement concerning the common ownership of Patent Application No. 09/452,751 (“the 09/452,751 application”). See M.P.E.P. § 706.02(1)(2). This Application and the 09/452,751 application were, at the time Applicant’s invention was made, owned by and subject to obligations of assignment to Cisco Technology, Inc.

Claim Objections

The Examiner objected to Claim 15 because of a perceived informality. Applicant amends Claim 15 as suggested by the Examiner to correct the perceived informality. Applicant therefore requests the Examiner to reconsider and withdraw the objection to Claim 15.

Claim Rejection - 35 U.S.C. §112

The Examiner rejected Claim 28 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Examiner contends that “[t]he phrase ‘a routing parameter set’ is indefinite because there are both ‘a first routing parameter set’ and ‘a second routing parameter set’.”

Applicant respectfully submits that Claim 28 particularly points out and claims the subject matter of Applicant’s invention. Claim 28, an independent claim, only includes one routing parameter set that is referred to three times: first as “a routing parameter set” and twice subsequently as “the routing parameter set.” Applicant therefore respectfully requests the Examiner to reconsider and withdraw the rejection of Claim 28.

Claim Rejections - 35 U.S.C. §103(a)

For the following reasons, Applicant respectfully requests reconsideration and withdrawal of the rejection of Claims 13-30.

Claims 13-15, 19-22 and 28-30

The Examiner rejects Claims 13-15, 19-22, and 28-30 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,389,024 issued to Ghai, et al. ("*Ghai*") in view of U.S. Patent No. 6,256,293 issued to Gerstel, et al. ("*Gerstel*"). To establish obviousness of a claimed invention under § 103, all claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974); M.P.E.P. § 2143.03.

Applicant respectfully submits that *Ghai* taken alone or in combination with *Gerstel* fails to teach or suggest all elements of Claim 13, which recites:

A method for associating routing parameters for a switch with line cards serviced by the switch, comprising:

programming a redirection memory to associate a routing parameter set in a routing memory for a switch with a first line card, the routing parameter set including a plurality of routing parameters to be provided to the switch to service the first line card; and

in response to an event initiating activation of a second line card in place of the first line card, reprogramming the redirection memory to associate the routing parameter set in the routing memory with the second line card.

Among other aspects of Claim 13, *Ghai* fails to teach or suggest "in response to an event initiating activation of a second line card in place of the first line card, reprogramming the redirection memory to associate the routing parameter set in the routing memory with the second line card." As teaching for these aspects, the Examiner cites to a configurable router table used to route calls in *Ghai*. However, a configurable router table fails to disclose "in response to an event initiating activation of a second line card in place of the first line card, reprogramming the redirection memory to associate the routing parameter set in the routing memory with the second line card."

The Examiner further states that *Ghai* "implicitly teaches that [the routing table] can be reprogrammed to adapt under certain conditions, just as it was programmed and stored in memory originally." Applicant respectfully disagrees. *Ghai* fails to disclose reprogramming or adapting the router table in response to any condition. To the extent that the Examiner maintains this assertion based on "Official Notice," "well known prior art," "common knowledge," or other information within the Examiner's personal knowledge, Applicant respectfully requests that the Examiner cite a reference in support of this position or provide

an affidavit in accordance with M.P.E.P. § 2144.03 and 37 C.F.R. § 1.104(d)(2). Furthermore, even if true, a reprogrammable routing table would still fail to teach or suggest “in response to an event initiating activation of a second line card in place of the first line card, reprogramming the redirection memory to associate the routing parameter set in the routing memory with the second line card” for substantially the same reasons discussed above.

Applicant further respectfully submits that the combination with *Gerstel* fails to remedy the shortcoming of *Ghai*, since *Gerstel* fails to teach or suggest any elements of Claim 13 not taught by *Ghai*. As an example, *Gerstel* fails to teach or suggest “in response to an event initiating activation of a second line card in place of the first line card, reprogramming the redirection memory to associate the routing parameter set in the routing memory with the second line card.” As teaching for these aspects, the Examiner cites to a portion of *Gerstel* that discusses rerouting channels on failed line cards to spare line cards. However, rerouting channels from one card to another simply does not show “in response to an event initiating activation of a second line card in place of the first line card, reprogramming the redirection memory to associate the routing parameter set in the routing memory with the second line card.”

Moreover, *Gerstel* actually teaches away from Applicant's invention. “A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” M.P.E.P. § 2141.02 (citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)). *Gerstel* proposes hardwiring various ports of different line cards together to solve the problem of failed line cards. *Gerstel*, Col. 3, lines 4-42. Thus, *Gerstel* teaches away from “in response to an event initiating activation of a second line card in place of the first line card, reprogramming the redirection memory to associate the routing parameter set in the routing memory with the second line card.”

Additionally, Applicant submits that there is no teaching, suggestion, or motivation to combine or modify the teachings of *Ghai* and *Gerstel* either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. “Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation

to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.” M.P.E.P. § 2143.01. “The mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” *Id.* Thus, the mere fact that the teachings of one reference would improve the teachings of another reference, as the Examiner asserts, does not provide the required suggestion to combine. Furthermore, nothing in *Ghai* or *Gerstel* suggests or motivates the proposed combination, nor has the Examiner provided evidence that suggests the proposed combination. Speculation in hindsight that it would have been obvious to make the proposed combination because the proposed combination would be helpful is insufficient under the M.P.E.P.¹ and governing Federal Circuit case law.²

For at least all of these reasons, Applicant respectfully requests reconsideration and withdrawal of the rejection of Claim 13. Claims 20 and 28 include elements comparable to the elements of Claim 13 just discussed. Thus, for substantially the same reasons as discussed above with regard to Claim 13, Applicant respectfully requests reconsideration and withdrawal of the rejection of Claims 20 and 28.

Claims 14, 15, and 19 depend from Claim 13; Claims 21 and 22 depend from Claim 20; and Claims 29 and 30 depend from Claim 28. Thus, because they depend from Claims shown above to be patentable, Applicant respectfully requests reconsideration and withdrawal of the rejection of Claims 14, 15, 19, 21, 22, 29, and 30.

¹ See M.P.E.P. § 2145 X.C. (“The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.”)

² For example, in *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999), the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that evidence of a suggestion, teaching, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant’s invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

Id. at 999 (emphasis added) (citations omitted).

Claims 16 and 23

The Examiner rejects Claims 16 and 23 under 35 U.S.C. §103(a) as being unpatentable over *Ghai* in view of *Gerstel* as applied to Claims 13-15 and 20-22 above, and further in view of U.S. Patent No. 5,598,409 issued to Madonna et al. ("*Madonna*"). Claims 16 and 23 depend from Claim 13 and 20 respectively, which were each shown above to be allowable over *Ghai* and *Gerstel*. The introduction of *Madonna* fails to provide the elements of Applicant's Claims 13 and 20 not shown by *Ghai* and *Gerstel*. Thus, for at least these reasons, Applicant respectfully requests reconsideration and withdrawal of the rejection of Claims 16 and 23.

Claims 17-18 and 24-25

The Examiner rejects Claims 17-18 and 24-25 under 35 U.S.C. §103(a) as being unpatentable over *Ghai* in view of *Gerstel* and *Madonna* as applied to Claims 13-16 and 20-23 above, and further in view of the 09/452,751 application. Applicant respectfully submits that the 09/452,751 application should be disqualified and excluded from this Examination. First, Applicant desires to make clear that Applicant has never represented the 09/452,751 application as prior art. Applicant disclosed the 09/452,751 application in a PTO-1499 mailed to the Examiner on August 30, 2002. On the same day, in an Information Disclosure Statement referring to the references disclosed in the PTO-1499, Applicant stated that "pursuant to 37 C.F.R. § 1.97(h), no representation is made that these references qualify as prior art." Therefore, Applicant objects to the Examiner's mischaracterization of this or any other reference as "admitted prior art."

Moreover, 35 U.S.C. § 103(c) forbids use of the 09/452,751 application to preclude patentability of Applicant's invention:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

As noted above, this Application and the 09/452,751 application were, at the time Applicant's invention was made, owned by and subject to obligations of assignment to Cisco Technology, Inc. Thus, the Examiner may not use the 09/452,751 application to support any rejections in the application currently at issue. See M.P.E.P. § 706.02(l)(2). Therefore, for at least this reason Applicant respectfully requests the Examiner to reconsider and withdraw the rejection based upon the 09/452,751 application.

Claims 26 and 27

The Examiner rejects Claims 26 and 27 under 35 U.S.C. §103(a) as being unpatentable over *Ghai* in view of *Madonna* and the 09/452,751 application. As discussed above, Applicant respectfully submits that the 09/452,751 application may not be used to support any rejections in the application currently at issue. Therefore, for at least this reason Applicant respectfully requests the Examiner to reconsider and withdraw the rejection based upon the 09/452,751 application.

New Claims

Applicant adds new Claims 31-38, which are fully supported by the specification as originally filed. For reasons similar to those discussed above, Applicant believes that all of these new claims are allowable over the cited art.

CONCLUSION

Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests full allowance of pending Claims 13-38. If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicant stands ready to conduct such a conference at the convenience of the Examiner.

The Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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